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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
01-185-A

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Signature *Lisa Schoedel*

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Application Number
10/087,651

Filed
March 1, 2002

First Named Inventor
Brent Townshend et al.

Art Unit
2655

Examiner
Michael N. Opsasnick

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)
- ☐ attorney or agent of record.
Registration number _____
- ☒ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 53,564

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May 1, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(MBHB Case No. 01-185-A)

In the Application of:)	
)	
Brent Townshend and Jared Bernstein)	Examiner: Michael N. Opsasnick
)	
Filing Date: March 1, 2002)	Group Art Unit: 2655
)	
Serial No.: 10/087,651)	
)	
For: A SYSTEM FOR MEASURING INTELLIGIBILITY)	
OF SPOKEN LANGUAGE)	

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REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicants request review of the Office Action mailed February 1, 2006 because the examiner made an error in law when responding to applicants' arguments.

1. The Claimed Invention

Applicants' claims are directed towards a system and method for measuring intelligibility of a speaker. Intelligibility is the degree to which others can understand a person's speech. (See, Applicants' Specification, page 2, lines 12-13.) Because the intelligibility of a speaker is based on a listener's perception of the speaker's speech, two people – the speaker and the listener – are elements of the claims. Specifically, each independent claim recites, in one way or another, a listener that repeats aloud what he hears the speaker say and an automatic speech recognition transcription system that prepares a

transcription of what the listener repeats aloud. The transcription is then compared to the text from which the speaker was reading to provide an intelligibility score for the speaker.

2. Status of the Claims

Claims 1, 2, 4-24, 26, 28, 29, 32-38, and 40-45 are currently pending. Claims 1, 11, 21, 24, 36, and 45 are independent claims. Claims 1, 2, 4-8, 11-18, 24, 26, 28, 29, 32, 33, 36, 37, 42, 44, and 45 stand rejected on grounds of obviousness over a combination of U.S. Patent No. 5,634,086 ("Rtischev"), U.S. Patent No. 6,122,614 ("Kahn"), and U.S. Patent No. 4,783,803 ("Baker"). Claims 9, 10, 19-23, 34, 35, 38, 40, 41, and 43 stand rejected on grounds of obviousness over a combination of Rtischev, Kahn, Baker, and U.S. Patent No. 5,059,127 ("Lewis").

3. Clear Legal Deficiency of Rejections

In response to applicants' argument that Rtischev, Kahn, and Baker are all silent with respect to:

- 1) a listener that hears a speaker repeating items and then repeats aloud what is heard;
- 2) automatically preparing a transcription of what the listener repeats aloud;
- 3) comparing the transcription of what the listener repeated aloud with the items repeated by the speaker; and
- 4) measuring intelligibility;

the examiner states that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references." (Office Action, page 5.) The examiner cites two cases for support of this legal conclusion. *Id.* However, neither of these cases have relevance here.

In *Keller*, the applicant argued that “the teachings of Walsh cannot properly be combined with those of either Keller or Berkovits because Walsh does not relate to a cardiac pacer.” *In re Keller*, 642 F.2d 413, 424 (CCPA 1981). The applicant’s invention was “to use a digital timing circuit in a cardiac pacer.” *Id.* at 425. However, “Keller and Berkovits disclose heart stimulators that use R-C type timing circuits” and “Walsh teaches the use of digital type timing circuits in place of R-C type timing circuits in conventional heart stimulators.” *Id.* The court found that it was proper to combine these references as Walsh relates to an analogous art. *Id.* at 424-425. Notably, the applicants did not argue that the references, when combined, would still be missing an element of the claims.

Similarly, the applicant in *Merck* contended that “there was no motivation in the prior art to arrive at appellant’s invention.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Moreover, the court held that “[n]onobviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references” in response to the applicant’s argument that one of nine references used to make the obviousness rejection teaches away from the applicant’s invention. *Id.* As in *Keller*, the applicant in *Merck* did not argue that the references, when combined, would still be missing an element of the claims.

In the present case, applicants have argued in five responses to Office Actions and during an Examiner Interview that none of the references cited have shown or suggested all the elements of the claims. In order to establish a prima facie case of obviousness of a claim over a combination of references, the examiner must establish that the combination teaches or suggests all of the claim limitations. MPEP § 2143. Thus, applicants believe that the examiner has failed to establish the requisite prima facie case of obviousness.

A. None of the references shows or suggests a listener as claimed. As described above, intelligibility is based on the listener's perception of what the speaker says. Accordingly, the claims require the listener to hear a speaker repeating items and then repeat aloud what is heard. Thus, the listener must be a different person than the speaker. The sole reference cited that describes more than one person is Kahn. However, Kahn's human operator does not repeat aloud what is heard. Instead, the human operator performs tasks that do not require the operator to speak, such as transcribing and editing files.

B. None of the references shows or suggests automatically preparing a transcription of what the listener repeats aloud. If none of the references suggests a listener that repeats aloud what is heard, then it follows that the references also do not suggest preparing a transcription of what the listener repeats aloud. The examiner even admits that the combination of Rtischev and Kahn does not teach this element. (Office Action, page 3.) Moreover, the examiner's own characterization of Baker highlights why Baker also does not show or suggest automatically preparing a transcription of what the listener repeats aloud as claimed.

As described by the examiner, Baker "teaches a microphonic input for a user to input for recognition" and "the output is in a word text format and is allowed to be edited by the user." (Office Action, page 3 (emphasis added).) As described by the examiner, only one human is involved – the user. Thus, Baker does not suggest a listener (nevermind a listener repeating aloud). Moreover, the user does not automatically edit an output, but rather makes a decision to edit. Accordingly, Baker also fails to show or suggest automatically preparing a transcription of what the listener repeats aloud.

C. None of the references shows or suggests comparing the transcription of what the listener repeated aloud with the items repeated by the speaker. As described above, none of the references suggest: 1) a listener repeating aloud the items repeated by the speaker; and 2) automatically preparing a transcription of what the listener repeats aloud. Thus, it follows that these references also do not suggest comparing the transcription of what the listener repeated aloud with the items repeated by the speaker. Without the claimed transcription, the claimed comparison cannot be performed.


D. None of the references shows or suggests measuring intelligibility. Rtischev describes a language instruction system. Kahn describes automating transcription services. Baker describes an improved speech recognition system. Because these references are concerned with solving other problems and are silent with respect to intelligibility, none of Rtischev, Kahn, and Baker show or suggest measuring intelligibility.

4. Conclusion

The combination of Rtischev, Kahn, and Baker does not result in the claimed invention as at least four claim elements are missing from the combination. Lewis, which was cited for the teaching of Item Response Theory, fails to overcome the deficiencies of Rtischev, Kahn, and Baker. For the foregoing reasons, applicants submit that all of the pending claims should be allowed.

Respectfully submitted,

Date: May 1, 2006

By: 
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